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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,878	02/22/2002	Kohki Katoh	219257US2	8566
22850	7590	03/23/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.			RODEE, CHRISTOPHER D	
1940 DUKE STREET			ART UNIT	
ALEXANDRIA, VA 22314			PAPER NUMBER	

1756

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/079,878

Applicant(s)

KATOH ET AL.

Examiner

Christopher D RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 9, 10 and 14-20 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8, 11-13, 21 and 22 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/12/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 January 2004 has been entered.

Response to Amendment

The amendment filed 29 January 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the additional description of the average particle diameter of the surface treated titania is without basis in the specification as filed and is not substantiated by the translation attributed to the priority document. Initially the Examiner notes that the translation has not been certified as accurate. Further, the passage supplied does not appear to correspond to Example 11 as discussed in the specification because this Example is stated as corresponding to Example 1 of the priority document, which is different from Example 11 in the specification, which is stated as being based on its Example 2. The composition and characteristics of the base examples are different. Further, there is no disclosure of the claimed particle size for the claimed titania. The amendment introduces new matter based on the evidence currently before the Examiner.

Applicant is required to cancel the new matter in the reply to this Office Action.

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Election/Restrictions

Claims 9, 10, and 14-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected method and apparatus, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the Paper of 11 April 2003. See remarks below concerning claims 21 and 22.

Claims 1-8 and 11-13 are directed to an allowable product. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims 21 and 22, directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, are now subject to being rejoined. Process claims 21 and 22 are hereby rejoined and fully examined for patentability under 37 CFR 1.104. In accordance with the Official Gazette notice, *supra*, process claims 9 and 10, which are not depend from or otherwise include all the limitations of the allowable product, have NOT been rejoined.

Claims 21 and 22 are allowed.

Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter: the previously applied rejections including Anno '386 and Takezawa '876 are withdrawn based on the recent claim amendments because these references and any supporting references do not suggest the claimed diameters of titania. Although the Bertrand, JP '847, and Otani references do cumulatively disclose or suggest characteristics of the claimed toner, there is not

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sufficient motivation to produce a toner having the colorant diameter of Bertrand, the titania characteristics from the JP reference (particularly for the claimed particle diameter), and the Dw/D₄ relationship of Otani. The art does not recognize sufficient nexus between these characteristics to make obvious the combination in a single toner.

This application is in condition for allowance except for the following formal matters:

- 1) the objection to the specification under 35 USC 132, discussed above, and
- 2) non-elected claims 9, 10, and 14-20.

The new matter in the specification must be removed or be shown to be present in a document incorporated by reference.

The non-elected claims must be canceled.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cdr
18 March 2004


CHRISTOPHER RODEE
PRIMARY EXAMINER